

I hereby certify that this correspondence is being filed via
EFS-Web with the United States Patent and Trademark Office
on March 8, 2010.

PATENT
Attorney Docket No. 026595-007610US

TOWNSEND and TOWNSEND and CREW LLP

By: /Sherry Soares/
Sherry Soares

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Michael J. Hafer, et al.

Application No.: 10/687,575

Filed: October 15, 2003

For: MONEY TRANSFER
CONVENIENCE CARD, SYSTEMS
AND METHODS

Confirmation No. 7753

Examiner: Lalita M. Hamilton

Art Unit: 3691

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

This Reply Brief is submitted in response to the Examiner's Answer mailed on January 7, 2010. The following remarks are intended to further focus the issues in this appeal.

Regarding the rejection of claims 23-29 under 35 U.S.C. § 101, the Appellants are unaware of the authority used by the Examiner to maintain the rejections. At page 6 of the Examiner's Answer, the Examiner responds to the Appellants' arguments stating, "the claim is directed towards a card whose embedded information is not executed by a computer. The physical nature of the card is not enough. The card must be used in conjunction with a computer to be considered statutory." This is the entirety of the Examiner's response. The Appellants believe this response fails to overcome the shortcomings of the rejection.

Claim 1 recites:

23. A money transfer convenience card that can be used to facilitate a money transfer transaction through a transaction provider, wherein the money transfer convenience card is associated with an account, such that when the money transfer convenience card is used to facilitate a money transfer transaction through the transaction provider, an award is credited to the account associated with the convenience card, the award being redeemable toward the purchase of a product from a service provider and being based at least in part on the money transfer transaction, the money transfer convenience card having stored thereon a list of recent money transfer transactions usable to initiate a subsequent money transfer transaction to a recipient identified in the list of recent money transfer transactions.

The claim is directed to a physical item, namely, a “money transfer convenience card.” By stating that, “the claim is directed towards a card whose embedded information is not executed by a computer. The physical nature of the card is not enough. The card must be used in conjunction with a computer to be considered statutory,” the Examiner appears to be applying authority and reasoning more applicable to a computer-implemented method claim. The reasoning is not applicable to a claim directed to a convenience card.¹ Accordingly, the Appellants maintain that the rejection is flawed, and respectfully request review.

Regarding the rejections of claims 30-47 under 35 U.S.C. § 101, the Examiner's position remains at odds with the Supreme Court's findings in *Bilski*, *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), 88 U.S.P.Q.2d 1385, wherein the Court states, “We further note for clarity that the electronic transformation of the data itself into a visual depiction in Abele was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented,” emphasis added (see *Bilski* at 1397). Claim 30 recites, “using stored transaction information identifying prior money transfer recipients of the customer obtained from the customer's account to automatically prepare a transaction form associated with the request to process the money transfer transaction; [and] visually displaying the transaction form.” The

Appellants maintain that this element satisfies the threshold requirement articulated by the Supreme Court in *Bilski*, and respectfully request review.

The Examiner's Answer maintains the rejections of claims 1-20 and 22-51 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0099607 A1 to Sosa et al. ("Sosa") in view of U.S. Patent No. 6,690,779 B2 to Walker et al. ("Walker"), and U.S. Patent No. 7,287,009 B1 to Liebermann ("Liebermann"). The Appellants respectfully request review of the Examiner's reasoning, namely that "the automatic population feature of Sosa as being capable of automatically populating any type of information into the form, including historical information of money transfer recipients. Further, automatically populating documents is not a novel feature. Therefore, the Examiner is interpreting the combination of references as reading onto the invention as claimed," (Examiner's Answer at p. 8). The Appellants believe this reasoning falls short of supporting a valid rejection for at least the following reasons.

Claim 1 recites: "return to the point-of-sale device stored transaction information identifying prior money transfer recipients of the customer for use by the point-of-sale device to automatically prepare a transaction form associated with the request to process the money transfer transaction" The remaining pending independent claims contain a limitation similar to this. Sosa's "valid charge information 617," (the claimed "stored transaction information"), is specifically defined in Sosa: "The valid charge number ABC 602 and the valid expiration date 604 are collectively shown as valid charge information 617." *Sosa*, ¶60. There is no teaching of "identifying prior recipients." The Sosa reference is used in combination with Liebermann's teaching of a funds transfer system. *Liebermann*, col. 11, ll. 55-57. Lieberman, however, specifically requires that "[t]o initiate such a transaction, the customer accesses the FCT system and enters . . . the intended recipients' FCT identification number, [and] the name of the person to whom the money is being transferred." *Id.*, at col. 11, ll. 58-64, emphasis added.

¹ Please also see Appellant's Brief at pp. 10, 11, and MPEP § 2106.01.

The recipient's name is not retrieved from prior transaction information. Further, similar information is not included in the valid charge information 617 of Sosa. Accordingly, the Record has not established that the prior art included the claimed feature of "return[ing] ... stored transaction information identifying prior money transfer recipients of the customer for use by the point-of-sale device to automatically prepare a transaction form."

The Liebermann reference does disclose a "Transaction-In-Process (TIP) form." *Id.*, at col. 15, ll. 59, 60. This TIP form does contain historical information; however the recipient's name is neither listed, nor retrieved to be sent to a point-of-sale device. *See, id.*, at Table II, col. 16. Moreover, Liebermann does not even teach that a customer's list of prior recipients are maintained. The historical information compiled by Liebermann appears to be used in the context of a single account accessible by only one user. Hence, "prior recipients" is irrelevant in the context of Liebermann's temporary account and associated historical information.

Accordingly, Liebermann's entirely conventional storage of historical data, combined with Sosa's population of a form using a charge number and expiration date, does not teach, suggest, or otherwise prove obvious "[returning] to the point-of-sale device stored transaction information identifying prior money transfer recipients of the customer for use by the point-of-sale device to automatically prepare a transaction form associated with the request to process the money transfer transaction," as recited in claim 1 and similarly recited in the remaining independent claims. Emphasis added.

For at least these reasons, the independent claims are not taught, suggested, or otherwise proved obvious by the cited references. Accordingly, Appellant respectfully requests reversal of the §103 rejections of the independent claims and their associated dependent claims.

Conclusion

For these reasons, it is respectfully submitted that the rejection should be reversed.

The Appellants maintain the propriety of the remaining arguments presented in the Appellant's Brief.

Respectfully submitted,

/Irvin E. Branch/

Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 303-571-4321
G2B:tnd
62482301 v1